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BEFORE THE BOARD OF APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Rine et al.

Serial No. 09/165,460

Filed: October 2, 1998

For: *AFC1 and RCE1: Isoprenylated
CAAX Processing Enzymes*

Group Art Unit: 1652

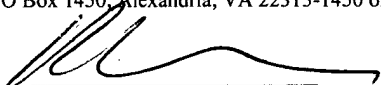
Examiner: Ramirez, D.

Attorney Docket No. B96-021-3

CERTIFICATE OF MAILING

I hereby certify that this corr. is being deposited with the US Postal Service as First Class Mail in an envelope addressed to the Comm. for Patents, PO Box 1450, Alexandria, VA 22313-1450 on August 19, 2003.

Signed


Richard Osman

REPLY BRIEF ON APPEAL

The Honorable Board of Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Honorable Board:

This Reply Brief is responsive to the Examiner's Answer dated May 20, 2003. The Answer withdraws rejection of claims 33-34 and 41-42 under 35USC103(a). Hence, these claims 33-34 and 41-42 stand allowable.

The Examiner introduces in her Answer, for the first time, new evidence to support her rejections. In particular, the Examiner relies on newly introduced, purported emails. Neither we nor the Board are able to consider the Examiner's newly proffered evidence in the form of an Answer. If the Examiner wishes to rely on new evidence to support her rejection, she may not introduce it for the first time in her Answer. Applicants have had no opportunity to confront or rebut this new evidence, and the Board may not consider unvetted evidence. In view of the Examiner's submission, this record is no longer ripe for review.

To the extent the Board nevertheless elects to review this record, we note only that the

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Examiner continues to allege as prior art publications that could not logically have existed prior to our filing date. Consider for example, her newly provided database accession "P47154". According to the Examiner and her purported emails, the date given in the first DT line of this entry (01-FEB-1996) is the date the entry first became available for public disclosure. But P47154 makes reference to publications from 1997, 1998 and 2000. In fact, the entry makes reference to post-filing publications of the present inventors describing the present invention. Absent a time machine, how could an entry making reference to publications in 2000 have been publicly available in 1996?

As we have repeatedly pointed out, the entire yeast genome was largely sequenced at the time this invention was made. Whether or not the yeast AFC1 or yeast RCE1 were sequenced prior to our filing date should be of no consequence, because their sequences, as part of the complete genomic sequence, are merely an inherent aspect of that genome. The invention derives from identifying and characterizing two genes in isolation from the genome, and this record provides no evidence that the claimed sequences were previously isolated, characterized or in any way identified apart from gross yeast genomic sequence.

The Rose et al. database entries indicate that they were data collected by the Munich information center for protein sequences (MIPS) on behalf of the European yeast chromosome X sequencing project. Similarly, the Lye et al. entries indicate that they were data collected for the *Saccharomyces cerevisiae* chromosome XIII sequence project. Both studies involved sequencing entire yeast chromosomes, and the associated entries, as originally submitted to Genbank, were no more than machine-predicted open-reading frames of raw genetic sequence. These original entries anticipate or render obvious expression vectors of isolated yeast genes little more than does the source yeast chromosome.

Of course, the database entries as recovered by the Examiner include annotations identifying the genes and their functions, as determined by the present applicants. Armed with this information, the entries provide motivation to create expression vectors. Without this information, the entries provide a list of every machine-construed ORF of the yeast chromosome. The Examiner identified and isolated the cited sequences from this vast, inherent set of machine-construed ORFs only by using our disclosed sequences as probes. Without the benefit of our

disclosure, what would direct one skilled in the art to these particular machine-constructed ORFs, and invest the time and money required to make the claimed expression vectors?

Appellants respectfully request reversal of the pending Final Action, or remand of this Application to the Examiner to create a reviewable record.

We petition for and authorize charging our Deposit Account No.19-0750 all necessary extensions of time. The Commissioner is authorized to charge any fees or credit any overcharges relating to this communication to our Dep. Acct. No.19-0750 (order B96-021-3).

Respectfully submitted,
SCIENCE & TECHNOLOGY LAW GROUP



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